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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/748,177	12/27/2000	Yuki Yamamoto	1046.1229/JDH	2992

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EXAMINER
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QUELER, ADAM M

ART UNIT	PAPER NUMBER
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2179

DATE MAILED: 01/05/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/748,177

Applicant(s)

YAMAMOTO ET AL.

Examiner

Adam M Queler

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-- The MAILING DATE of this communication appears on the cover sheet with the corresponding address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-12, 21-24 and 29-34 is/are pending in the application.
- 4a) Of the above claim(s) 29 and 30 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-12, 21-24 and 31-34 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 27 December 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All \* b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 09/01/2004.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: IDS: 8/16/2001, 02/02/2001.

### **DETAILED ACTION**

1. This action is responsive to communications: Information Disclosure Statements filed 09/01/2004, 08/16/2001, 02/02/2001, and Response to Restriction filed 07/30/2004.

2. Claims 1-12, 21-24, and 29-34 are pending in the case. Claims 1, 8, 21, 23, 29, 30, 31, and 33 are independent claims. Claims 29 and 30 are withdrawn.

#### ***Election/Restrictions***

3. Claims 29 and 30 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected group, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on 07/30/2004.

#### ***Information Disclosure Statement***

4. The information disclosure statement filed 09/01/2004 fails to comply with the provisions of 37 CFR 1.97, 1.98 and MPEP § 609 because the AG reference has already been submitted with a previous IDS (8/20/2000) and therefore as been crossed out on 9/1/2004 IDS.

#### ***Specification***

5. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

#### **Content of Specification**

- (f) Brief Summary of the Invention: See MPEP § 608.01(d). A brief summary or general statement of the invention as set forth in 37 CFR 1.73. The summary is separate and distinct from the abstract and is directed toward the invention rather than the disclosure as a whole. The summary may point out the advantages of the invention or how it solves problems previously existent in the prior art (and preferably indicated in the Background of the Invention). In chemical cases it should point out in general terms the utility of the invention. If possible, the nature and gist of the invention or the inventive concept should be set forth. Objects of the invention should be treated briefly and only to the extent that they contribute to an understanding of the invention.

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6. The "Brief Summary of the Invention" is objected to because it is nothing more than a recitation claims in sentence form.

***Claim Rejections - 35 USC § 112***

7. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

8. **Claim 4 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement.**

The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The term "processing-object tagged document" is not defined in the specification nor is it's meaning commonly known.

9. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

10. **Claims 2 and 4 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.**

Claim 2 recites the limitation "original-versus-version." While the term is mentioned in the specification, it is not defined nor claimed in any definite manner that would clearly point out the metes and bounds of the patent protection desired.

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Claim 4 recites the limitation "the processing-object tagged document" in line 3. There is insufficient antecedent basis for this limitation in the claim. As this term is also not defined in the claim as noted above, it will be broadly interpreted for examining purposes only to mean a tagged document.

***Claim Rejections - 35 USC § 103***

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

12. **Claims 1-4, 7-9, 12, 21, 23, 31, and 33 rejected under 35 U.S.C. 103(a) as being unpatentable over Kumano et al. (US006047252A, filed 6/30/1997) and further in view of Ando et al. (US006523000B1, filed 12/27/1999).**

**Regarding independent claim(s) 1, 21, and 31,** Kumano teaches setting a language tag designating a type of language (col. 6, ll. 3-7). Kumano teaches that the tags are attached to constituent units of the original and translated portions (col. 4, ll. 38-45). Kumano does not teach combining these documents together. Ando teaches combining an original and a translated version together (Fig. 7). It would have been obvious to one of ordinary skill in the art at the time of the invention to combine Ando and Kumano, thereby combining the original and translated tagged documents together, for the purpose of presenting them for user review (Ando, col. 1, ll. 17-18).

**Regarding independent claim(s) 8, 23 and 33,** Kumano teaches setting a language tag designating a type of language (col. 6, ll. 3-7). Kumano teaches that the tags are attached to

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constituent units of the first and second portions (col. 4, ll. 38-45). Kumano does not teach combining these documents together. Ando teaches combining a first and second version together (Fig. 7). It would have been obvious to one of ordinary skill in the art at the time of the invention to combine Ando and Kumano, thereby combining the original and translated tagged documents together, for the purpose of presenting them for user review (Ando, col. 1, ll. 17-18).

**Regarding dependent claim(s) 2**, as the two versions of Ando and Kumano are combined as described in claim above, that form is broadly considered to be in original-versus-version form.

**Regarding dependent claim(s) 3**, Kumano teaches translating the original to create the translated version c4.46-52.

**Regarding dependent claim(s) 4**, Kumano teaches the original is in a tagged document (Fig. 5).

**Regarding dependent claim(s) 7 and 12**, Kumano teaches that a browser interprets and displays the tags c6.21-27.

**Regarding dependent claim(s) 9**, Kumano teaches the texts are related to each other (col. 4, ll. 38-45)

**13. Claims 5, 6, 10, 11, 22, 24, 32 and 34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kumano and Ando as applied to claims 1, 8, 21, 23, 31, and 33 above, and further in view of Furman et al., "Positioning HTML Elements with Cascading Style Sheets, W3C Working Draft 31-Jan-1997" (<http://www.w3.org/TR/WD-positioning-970131>).**

**Regarding dependent claim(s) 5, 10, 22, 24, 32 and 34**, Kumano and Ando teach tags as set forth in claim 1 above. Kumano and Ando do not teach a visibility tag. Furman teaches two div

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tags with CSS property's that make the div tags, a visibility tag and invisibility tag, respectively (Furman §2.5, ex. 8). It would have been obvious to one of ordinary skill in the art at the time of the invention to combine Furman with Kumano and Ando, thereby using CSS to make the tags Kumano and Ando, visibility/invisibility tags which would make one of the original or translated versions invisible. This would have been obvious because it would expose the web page to dynamic scripting (Furman §2.5, ex. 8).

**Regarding dependent claim(s) 6 and 11,** Kumano, Ando and Furman teach that one of the versions is invisible as explained in claim 5 above. Additionally, since the tags are HTML, all tags, including the invisibility tag, would inherently be in an invisible state.

#### ***Conclusion***

14. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Adam M Queler whose telephone number is (571) 272-4140.

The examiner can normally be reached on Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Heather R Herndon can be reached on (571) 272-4136. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system; contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

AQ

BA HUYNH  
PRIMARY EXAMINER